

**REMARKS**

In response to the pending Office Action, claim 20 is amended. Claims 1-4, and 10-19 were withdrawn without prejudice. Claims 20-23 were withdrawn by the final Office Action dated September 24, 2007 as allegedly directed to a non-elected invention. No new matter has been added.

**Applicants have amended claim 20 to depend from elected independent claim 5, and submit that claim 20-23 are directed to an elected invention according to elected independent claim 5.** Claims 5-9 and 20-23 are currently active for examination, of which claim 5 is the only independent claim.

Claims 5-7 and 9 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Miyazaki et al. (EP Patent Application Publication No. 1094424). The rejection is respectfully traversed.

Claim 8 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Miyazaki (EP No. 1094424) in view of Bisbee. Office Action at 7-9. The rejection is respectfully traversed.

Independent claim 5 recites, in part:

accepting the log list from the digital signature issue side apparatus,  
verifying validity of the digital signature of a digital signer signed on the log list  
or log list registration request data,  
verifying consistency between the accepted log list and a registered log list of a  
registered digital signer,  
adding and registering the accepted log list with the confirmed consistency to the  
registered log list of the digital signer, and  
registering a user of the signature history storage service apparatus who is a  
digital signer of the digital signature issue side apparatus.

As is well known, anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single

prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). The elements must be arranged as required by the claim. *In re Bond*, 910 F. 2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Office Action, at pages 4-6, asserts that all of the elements of claim 5 are disclosed by Miyazaki (EP No. 1094424). Miyazaki (EP No. 1094424) was published in English on April 25, 2001. Thus, **April 25, 2001 is the effective date under 35 U.S.C. § 102(b).**

However, the present application has been amended to claim the benefit of priority under 35 U.S.C. § 120 as a continuation in part of prior filed U.S. Application No. 11/999,373, which is a continuing application of prior filed U.S. Application No. 09/693,713 filed on October 19, 2000, now U.S. 7,305,558. The present application was filed during the pendency of the earlier applications, and therefore it meets copendency requirements.

It is respectfully submitted that Miyazaki (EP No. 1094424) is not an anticipatory reference against any claim in this CIP application. Any claims herein directed to subject matter that is fully disclosed by Miyazaki (EP No. 1094424) and/or its earliest U.S. equivalent case (U.S. Application No. 09/693,713) are entitled, at a minimum, to the October 19, 2000 filing date of the earliest U.S. ancestor. With respect to such pending claims, the cited Miyazaki (EP No. 1094424) is not **prior art** under 35 U.S.C. § 102(a) or (b).

Since Miyazaki (EP No. 1094424) is not prior art, and therefore claims 5-7 and 9 (and claims 20-23) are not anticipated by Miyazaki (EP Patent No. 1094424). Hence, at least claims 5-7 and 9 should be allowable.

Under Federal Circuit guidelines, a dependent claim is allowable if the independent claim upon which it depends is allowable because all the limitations of the independent claim are

contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987).

Thus, as independent claim 5 is allowable for the reasons set forth above, it is respectfully submitted that dependent claims 6, 9, and 20-23 are allowable for at least the same reasons.

Claim 8 also is believed to be patentable over Miyazaki (EP Patent No. 1094424) and Bisbee for reasons discussed in the preceding response.

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call the undersigned attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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